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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/492,398
Filing Date: January 27, 2000
Appellant(s): Dr. Al J. Mooney

Stephen G. Herrera
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 23, 2005 appealing from the Office action mailed February 18, 2004.

Preliminary Note Regarding Format of Brief: Appellant's first version of the appeal Brief was filed prior to PTO rule changes implementing 37 CFR 41.37. Accordingly, appellant's brief of May 23, 2005 filed in accordance with 37 CFR 1.192(c) is considered to be in proper form for appeal, even though it was filed after the implementation of 37 CFR 41.37. Examiner confirms consultation (by both appellant and examiner) on this matter with Kery Fries of the Office of Patents Legal Administration who confirmed appellant's ability file the brief in accordance with the rule set in force prior to the implementation of 37 CFR 41.37. Accordingly, appellant's format of the brief is accepted.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendments after the final rejection have been submitted, Appellant did submit exhibit documents after the final rejection, dated May 23, 2005. These documents were denied entry in the advisory action of December 8, 2005.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter is acceptable. See "Preliminary Note Regarding Format of Brief" set forth above.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct, and is set forth in section (6) of the Brief.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 50-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver (U.S. Patent 6,269,339).

Claim 50: Silver discloses a physician's website (FIG. 1) in which a patient is presented with a questionnaire (FIGS. 4-6). The questionnaire is considered to be a medical examination and the completion of the questionnaire is the action of conducting the examination. The medical examination is considered to be conducted by the medical care provider since the questionnaire is provided by the medical care provider (Dr. Roizen—FIG. 2). As seen in FIG. 19, the result of the examination is that the patient is prescribed very specific medical products, such as specific vitamins. The screen shots shown in FIGS. 18-19 are also websites which the patient can access and which contains the array of medical products which are prescribed for the patient. The

patient can order a medical supply by clicking on one of the "Products" boxes shown in FIGS. 18-19 and be led to a website for a vendor that distributes that product (col. 18, lines 26-45). The patient then orders the supply from that vendor. The medical care provider which prescribes the supply may also receive a fee for endorsing the products which are recommended to the patient (col. 19, line 1-7).

Claim 51: Col. 18, lines 26-45 refer to product merchants who are vendors of medical supplies that receive orders that are placed with the assistance of the physician's website.

Claim 52: FIG. 19 illustrates vitamins as being the medical supply being distributed. Individual vitamins or packages of vitamins are considered readable as devices for medical purposes.

Claim 53: The vitamins illustrated in FIG. 19 are considered to be pharmaceutical products.

Claim 54: The physician may also be considered as a vendor of supplies since the physician cooperates with the vendor by providing a website that aids in vending supplies (col. 19, lines 1-7 and FIG. 19).

Claim 55: The e-commerce provider is the physician and the website associated with the physician (FIG. 2 is the first page of this website). Payment of the product vendor is facilitated through this website since the patient cannot reach the product vendor unless directed to the vendor by the website.

Claim 56: The e-commerce provider is the physician and the website associated with the physician. Since the physician receives payments for product endorsements (col. 19, lines 1-7), the physician will inherently receive money into a physician's account (such as the physician's

bank account) from an account associated with the supply vendor (such as the merchant's bank account). Normal transactions on such accounts include debits and credits.

Claim 57: The e-commerce provider is the physician and the physician's associated website.

Claim 58: See remarks for claim 56.

Claim 59: The e-commerce provider is the physician and the website associated with the physician. Since the physician cooperates with the supply vendor by endorsing medical supplies, the physician may also be considered a vendor of supplies.

Claim 60: See remarks for claim 56.

Claim 61: See the description of the physician in FIG. 2.

Claim 62: See remarks for claim 50.

Claim 63: See remarks for claim 55.

Claim 64: See remarks for claim 56.

Claim 65: See remarks for claim 57.

Claim 66: See description of physician in FIG. 2.

Claim 67: The physician's website is a website on the Internet (col. 8, line 16).

(10) Response to Argument

Group I: Claims 50-51, 53, 55-56, 58-59 and 61

Arguments for this group are directly exclusively to claim 50. Appellant's first argument is that Silver does not teach the performance of a "medical examination", as defined in claim 50. Examiner maintains that the questionnaire accomplishes the medical examination and the completion of the questionnaire correlates to the action of conducting the medical examination.

In reaching this determination, examiner has drawn upon both intrinsic and extrinsic evidence, with greater weight given to intrinsic evidence. See *Phillips v. AWH Corp.*, 75 USPQ 2d 1321, (CAFC 2005). It has been found that the term "medical examination" is never invoked in the specification. Accordingly, it is clear from the outset that the specification provides no definition of this term or usage of this term in context. Next, examiner has reviewed the specification to determine if related concepts are discussed, relying on appellant's own arguments to locate the related concepts. Appellant states in the brief at page 7, second paragraph, line 12 that the specification describes this concept at page 2, lines 18-19 and page 3, line 18 through page 4, line 4. The quotation from pages 3-4 do not appear to contain any discussion or definition for the concept of examining a patient. Additionally, no specific definition is provided. The quotation from page 2 makes reference to an "appropriate consultation", but does not state what constitutes such a consultation, or what has to be done to make it "appropriate". Examiner maintains that given that lack of any concrete definition of this term, the "consultation" and "examination" can be any one of myriad of medical actions, including the eliciting of information for analysis, as taught by Silver.

As for consideration of extrinsic evidence, examiner finds that there is no one single definition for what constitutes a "medical examination". A skilled artisan would recognize that a doctor is not limited to performing one and only one technique for examining a patient. An examination could be achieved by anything from asking questions to inserting invasive devices under anaesthesia. There is no one standard, "catch all" medical examination that is known in the art and used in every instance, so the examiner can draw from various interpretations as to what the term "medical examination" actually means. Examiner maintains that completing the

questionnaire of Silver achieves one manner of examination, from the multitude of possible examinations that are available to a medical practitioner. The examination is conducted by the provider (see FIG. 2) using the medium of the website. The provider need not physically see the patient, and the specification provides no suggestion of such direct contact.

Appellant also argues that Silver does not teach the required step of prescribing a medical supply, as defined in claim 50. Here, appellant does provide a specific definition in the specification at page 4 lines 3-4. The definition is intrinsic evidence which is given greater weight for the meaning of the term. (*Phillips v. AWH Corp.*, cited herein) Specifically, appellant states:

Further, as used herein, "prescribed" shall be interpreted as to "designate or order the use of, as a remedy.

In Silver, the patient examination is achieved through interaction with a website and as seen in FIG. 19, certain remedies are specifically designated and ordered to be used by the client, including specific products, such as vitamins. The actions defined in appellant's specification match the actions taken in Silver, so examiner maintains that Silver teaches the claimed feature of prescribing a medical supply. Appellant also asserts that this feature refers to preparation of a prescription for a prescription drug obtained at a pharmacy (page 11 of arguments, second paragraph), although it is clear from appellant's own self-supplied definition in the specification that this is not a requirement.

Thirdly, appellant argues that in Silver, the medical care provider never receives payment, because the medical care provider is not the system operator who is designated to receive payment. This argument is not correct. The only system operator disclosed in Silver is

"Dr. Michael Roizen" (FIG. 2), so it is clear that Dr. Roizen is receiving the described compensation, and Dr. Roizen is the recited medical care provider. It is also noted that appellant does not identify who the system operator should be, if it were somehow not Dr. Roizen.

Group II: Claim 52

Appellant argues that Silver does not teach the usage of "medical devices". The term medical devices is referred to in the specification at page 3, last line through page 4, first line. The discussion references crutches, splints, bandages, etc. However, appellant does not refer the next sentence of the specification which states (emphasis added):

"This list is intended to be exemplary and not limiting with respect to items that fall within the definition of the term "medical device".

By appellant's own admission, there is no limiting definition of the term "medical device" in the specification. Accordingly, appellant's argument that the term "medical device" is limited to bandages and splints is contradicted by appellant's own disclosure. Examiner thus maintains that a broader reading is permissible, and that vitamins or packages of vitamins would be readable as the claimed medical devices, since they are therapeutic in nature and intended as a medical treatment for a defined problem. Contrary to appellant's arguments, this is not an arbitrary meaning assigned to the term, but a meaning allowed by appellant's own exception to the provided definition.

Group III: Claim 54

Appellant argues that in Silver, the medical care provider and vendor are not one and the same. This argument is not correct. FIG. 2 establishes that "Dr. Michael Roizen" is the medical

care provider. Since the medical care provider is cooperating with a vendor by providing a website that aids in vending supplies, the provider is functioning as a vendor.

Group IV: Claim 57

Appellant argues that Silver does not disclose an e-commerce provider providing credits or debits. These arguments are moot for this particular claim since this feature is not required in claim 57. Claim 57 only recites that the medical care provider is an e-commerce provider. This is clearly demonstrated in FIG. 2, where Dr. Michael Roizen is both a medical care provider and the sponsor of a website on the Internet.

Group V: Claim 60

Appellant argues that claim 60 is addressed to crediting or debiting an account of both a medical care provider and vendor. Although examiner refers to arguments in claim 56, the discussion associated with claim 56 specifically addresses how the physician receives a credit based on a debit from a vendor, as described at col. 19, lines 1-7. The physician is the operator of the invention referred to in col. 19, lines 1-7, and receives a paid fee for advertising a product, which from a banking perspective, constitutes a credit on an account. The payer of that fee would inherently receive a corresponding debit. The payment necessarily derives from the vendor, since there are no other possible parties within the system that would pay for advertising a product, and there is no indication that the patient makes (or even would want) to provide such payment.

Group VI: Claim 62

Appellant asserts that the medical care provider does not receive an order for products. This assertion is not correct. The medical are provider is "Dr. Michael Roizen", as seen in FIG. 2. Dr. Roizen is clearly operating website that receives orders (selections for products FIGS. 18-21). The feature of ordering medical supplies is also addressed in claim 50, which is one of several reasons why examiner referenced claim 50 in this discussion. Contrary to appellant's assertion, the reference to a discussion of a different claim is not a "wave of the hand" (page 20, second paragraph of the brief). The discussion associated with claim 50 contains explicit identification of how the ordering is accomplished, including references to FIGS. 18-19.

Group VII: Claim 64

Appellant asserts that Silver does not disclose the crediting or debiting an account associated with the medical care provider. This not correct. In the final office action, the examiner referred to claim 56, which indicates that the medical care provider receives payments (col 19, lines 1-7). Such payments constitute credits to the account receiving this payment. It should also be noted that the claim recites "credits or debits", so there is no requirement that Silver teach both crediting and debiting, but only one of the two.

Group VIII: Claim 65

Claim 65 contains the same limitations as claim 57, which was already addressed with group IV. Accordingly, examiner maintains that claim 65 should stand or fall with Group IV. The discussion associated Group IV is incorporated by reference herewith.

Group IX: Claim 66

Claim 66 calls for the medical care provider to be a licensed provider. FIG. 2 clearly identifies Michael Roizen as "DR." and thus references a licensed medical care professional.

Appellant provides no reasons as why the "DR" would not be considered licensed, and instead refers to claim 62, which is moot.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sam Rimell
Primary Examiner
Art Unit 2164

Conferees:

C1/ SAM RIMELL
C2 JOE DIXON

APPEAL CONFERENCE HELD JULY 21, 2006. AGREEMENT TO PROCEED ON APPEAL.